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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,966	11/14/2000	Scott D. Landes	5482	6125

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EXAMINER

COURSON, TANIA C

ART UNIT PAPER NUMBER

2859

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/710,966

Applicant(s)

LANDES, SCOTT D.

Examiner

Tania C. Courson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claim 11 is objected to because of the following informalities: "said anchoring flaps" in lines 1-2 lacks antecedent basis. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebinger (US 3,709,112) in view of Stuart (US 6,461,084).

Ebinger discloses in Figures 1-2, a guide post comprising:

With respect to claims 1-7 and 11-12:

- a) a hollow elongated member (Fig. 1, road guide post 1), said elongated member composed of a flexibly resilient polymer plastic (column 1, lines 50-67), said elongated member having a first end and a second end (Fig. 1);
- b) wherein said polymer plastic is polycarbonate or polyethylene (column 1, lines 54-55);

- c) wherein said elongated member is triangular, circular, rectangular or square shaped (Figs. 1-2) and said elongated member includes a non-tapered exterior surface (Fig. 1).
- d) wherein said elongated member is weather resistant (column 2, lines 49-53);
- e) including a weather resistant cap for covering the first end of said elongated member to prevent rain or snow from entering the elongated member (Fig. 1, cover 4);
- f) wherein said elongated member is sufficiently stiff to permit the marker post to be driven into a top layer of soil (Fig. 1).

With respect to claims 8-10:

- a) a triangular shaped elongated member (Fig. 1, road guide post 1) having a first panel, a second panel, and a third panel forming the elongated member (Fig. 1), said elongated member composed of a flexibly resilient polymer plastic (column 1, lines 50-67) and said triangular shaped elongated member having a first open end and a second open end (Fig. 1);
- b) wherein said polymer plastic is polycarbonate or polyethylene (column 1, lines 54-55);
- c) wherein said elongated member is sufficiently stiff to permit the marker post to be driven into a top layer of soil (Fig. 1).

Ebinger does not disclose a first integral anchoring flap, a second integral anchoring flap, and a third integral anchoring flap, each of said anchoring flaps having a first end and a second end, each of said anchoring flaps located proximate a second end of said elongated member, a first hinge, a second hinge, and a third hinge, the second end of said first anchoring flap attached to the first panel of said elongated member by said first hinge, the second end of said second anchoring flap attached to the second panel of said elongated member by said second hinge, the second end of said third anchoring flap attached to the third panel of said elongated member by said third hinge, each of said anchoring flaps moveable from a first closed position to facilitate the handling and transportation of said marker post to a second open position to prevent the withdrawal of said elongated member from an embedded position.

With respect to a first integral anchoring flap, a second integral anchoring flap, and a third integral anchoring flap, each of said anchoring flaps having a first end and a second end, each of said anchoring flaps located proximate a second end of said elongated member, a first hinge, a second hinge, and a third hinge, the second end of said first anchoring flap attached to the first panel of said elongated member by said first hinge, the second end of said second anchoring flap attached to the second panel of said elongated member by said second hinge, the second end of said third anchoring flap attached to the third panel of said elongated member by said third hinge, each of said anchoring flaps moveable from a first closed position to facilitate the handling and transportation of said marker post to a second open position to prevent the withdrawal of said elongated member from an embedded position, Stuart teaches a post that consists of a first integral anchoring flap, a second integral anchoring flap, and a third integral

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anchoring flap (Figs. 1 and 4, deflectable portions 11), each of said anchoring flaps having a first end and a second end (Figs. 1 and 4), each of said anchoring flaps located proximate a second end of said elongated member (Figs. 1 and 4), a first hinge, a second hinge, and a third hinge (Figs. 1 and 4, deflectable portions 11), the second end of said first anchoring flap attached to the first panel of said elongated member by said first hinge (Fig. 1), the second end of said second anchoring flap attached to the second panel of said elongated member by said second hinge (Fig. 1), the second end of said third anchoring flap attached to the third panel of said elongated member by said third hinge (Fig. 1), each of said anchoring flaps moveable from a first closed position to facilitate the handling and transportation of said marker post (column 3, lines 37-40) to a second open position to prevent the withdrawal of said elongated member from an embedded position (column 3, lines 37-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the guide post of Ebinger, so as to include integral anchoring flaps with hinges attached to a panel, as taught by Stuart, so as to enhance the engagement of the post to the ground (column 3, lines 39-40).

Once modified, since the hinge and flap are integral to a material and perform the same function, therefore the hinge and flap are considered to be a “flexible living hinge”, as well as “weather resistant”, upon modification of Ebinger in view of Stuart.

Furthermore, it is noted that Stuart normally has the flaps/deflectable portions in a closed position since there are “a number of deflectable portions, such as 11 which may be pushed from

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the fin 1a so as to enhance the engagement of the fin with the ground” (column 3, lines 37-40), therefore it is implied that the flaps/deflectable portions remain closed from manufacturing to the seller to the user up to prior to inserting the post into the ground. It is also implied, with respect to Stuart, that the user “pushes” the deflectable portions into an open position, similar to the applicant’s specification (page 4, line 27 through page 5, line1) which states “The hinges are sufficiently flexible so that the user can bend the flaps out”.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7 and 11-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,099,203 in view of Ebinger (US 3,709,112). The limitations as stated in claims1-7 and 11-12 of this

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application are indicated in the combination of claims 1-4 of U.S. Patent No. 6,099,203 (Landes) in view of U.S. Patent No. 3,709,112 (Ebinger).

6. Claims 8-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 4 of U.S. Patent No. 6,099,203 in view of Ebinger (US 3,709,112). The limitations as stated in claims 8-10 of this application are indicated in the combination of claims 1-2 and 4 of U.S. Patent No. 6,099,203 (Landes) in view of U.S. Patent No. 3,709,112 (Ebinger).

#### ***Response to Arguments***

7. Applicant's arguments filed on July 28, 2003 have been considered but are moot in view of the new ground(s) of rejection.

8. The applicant should note that the arguments made with respect to Stuart (page 5, 1<sup>st</sup> paragraph) in the amendment filed on July 28, 2003, show an improper reference to Stuart, the "separate members 35" are actually found in Arthur (US 4,522,530), not in Stuart (US 6,461,084 B1).

9. Claim 17 should be included in the listing of cancelled claims in the amendment filed on July 28, 2003 based on cancellation of claims in the amendment filed on January 22, 2003.



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10. With respect to the arguments made in reference to Double Patenting, the obviousness type Double Patenting rejection remains with a change in the secondary reference utilized. The applicant's prior patent US 6,099,203 shows a triangular shaped resilient marking post including panels (Fig. 1, panels 11-13) and the secondary reference is what is utilized to show the anchoring flaps, this would constitute a proper obviousness type Double Patenting. Furthermore, it should be noted that the applicant's patent and the secondary reference are both posts with similar functions, thus analogous art, thus are not separate and distinct inventions from one another.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (571) 272-2239.

The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (571) 272-2245.

The fax number for this Organization where this application or proceeding is assigned is (703) 872-9306.



DIEGO F.F. GUTIERREZ  
SUPERVISORY PATENT EXAMINER  
GROUP ART UNIT 2859

TCC  
April 29, 2004

**CHRISTOPHER W. FULTON**  
**PRIMARY EXAMINER**